

INTERFERENCE DIGEST

Interference No. 105,298

Paper No.

Name: Gerhard Hoefle et al.

Serial No.: 09/313,524

Patent No.

Title: Epothilones C, D, E and F, preparation and composition

Filed: 05/17/99

Interference with Danishefsky et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, _____ Dated, _____

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.



UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Richard Torczon
Telephone: 571-272-9797
Facsimile: 571-273-0042

MAILED

APR 4 - 2005

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Applicants: HOEFLE
Application No.: 09/313,524
Filed: 05/17/99
For: Epothilones C, D, E and F, preparation
and composition

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,298.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

RICHARD TORCZON
Administrative Patent Judge

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Alexandria, Virginia 22313-1450
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Paper 1

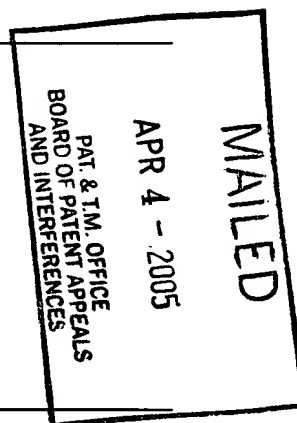
UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,298

GESELLSCHAFT FÜR BIOTECHNOLOGISCHE FORSCHUNG MBH
(09/313,524),
Junior Party,

v.

SLOAN-KETTERING INSTITUTE FOR CANCER RESEARCH
(6,242,469 B1 and 6,284,781 B1),
Senior Party.



DECLARATION - Bd.R. 203(b)

By TORCZON, Administrative Patent Judge.¹

A. Declaration of interference

An interference is declared (35 U.S.C. 135(a)) between the captioned parties.

Details of the application, patents, count, and claims designated as corresponding to the count appear under headings E and F of this DECLARATION.

B. Administrative patent judge designated to administer the contested case

Administrative Patent Judge Richard Torczon has been designated to administer this contested case. 37 CFR § 41.104(a) [Bd.R. 104(a)].

¹ As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 C.F.R. § 10.18.

C. Standing order

A copy of the Trial Section STANDING ORDER [SO] (Paper 2) accompanies this DECLARATION. The STANDING ORDER applies to this contested case.

D. Conference call to set dates

A telephone conference call to set dates for action in this contested case is scheduled for **2 p.m. (Eastern) on 1 June 2005**. (The Board will initiate the call.)

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile (SO ¶ 4.5) a list of the motions (Bd.R. 120; Bd.R. 204; SO ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

The Board is conducting a pilot program in electronic filing of papers (Bd.R. 106(d)(2)). The procedure is explained in University of New Mexico v. Fordham Univ., No. 104,761, Paper 21 (2001).² Counsel should be prepared to discuss participation in the pilot program.

² <http://www.uspto.gov/web/offices/dcom/bpai/its/104761-021.pdf>.

E. The parties to this interference

Junior Party

Application: 09/313,524, filed 17 May 1999

Title: Epothilones C, D, E, and F, preparation and compositions

§102(g) benefit: None

Senior Party

Patents: 6,284,781 B1, [781] issued 4 September 2001
(09/691,615, filed 18 October 2000) and
6,242,469 [469], issued 5 June 2001
(08/986,025, filed 3 December 1997)

Title: Synthesis of epothilones, intermediates thereto, analogues and uses thereof

§102(g) benefit: 60/055,533, filed 13 August 1997;
60/047,941, filed 29 May 1997;
60/047,566, filed 22 May 1997;
60/033,767, filed 14 January 1997; and
60/032,282, filed 3 December 1996

F. Count and claims of the parties

Count 1: The compound of 469 claim 1.

The claims of the parties are:

GBF: 1-4, 15, 16, and 18-20

SKI: 781 - 1-37; and 469 - 1-22

The claims corresponding to Count 1:

GBF: all

SKI: 781 - 1, 2, 5-23, 27-30, and 34-37; and 469 - all

The claims not corresponding to Count 1:

GBF: none

SKI: 781 - 3, 4, 24-26, and 31-33; and 469 - none

G. Heading to be used on papers

Addendum 1 provides the heading that shall be used on all papers filed in the contested case. See SO ¶ 7.2.1.

The range of exhibit numbers is assigned as follows (Bd.R. 154(c)(1); SO ¶ 20.2.1):

Sloan-Kettering Inst.: 1001-1999.

GBF: 2001-2999.

H. Order form for requesting file copies

When requesting copies of files, use of Addendum 2 (SO Form 4) will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

I. Required paragraph for affidavits and declarations

The Board has recently experienced a rash of cases in which a witness has belatedly advanced reasons why he or she would be unable to appear for cross examination at a reasonable time and place in the United States. Consequently, the Board is requiring the following paragraph to be included on the signature page of all affidavits (including declarations) filed in this case to prevent surprise and hardship to the party relying on the testimony of the witness:

In signing this affidavit/declaration, I recognize that the affidavit/declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place

within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

Enclosures:

Copy of STANDING ORDER (Paper 2)
Copy of the application claims for 09/313,524

cc (via overnight delivery):

For Gesellschaft für Biotechnologische Forschung mbH:

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Interference No. 105,298
GBF v. Sloan-Kettering Inst.

Paper 1
Page 6

ADDENDUM 1

Filed on behalf of: [Name of Party]
By: [Name of lead counsel
Name of backup counsel
Street address
City, State, and ZIP Code
Tel:
Fax:]

Paper No. [Leave blank]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Torczon)

GESELLSCHAFT FÜR BIOTECHNOLOGISCHE FORSCHUNG MBH
(09/313,524),
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SLOAN-KETTERING INSTITUTE FOR CANCER RESEARCH
(6,242,469 B1 and 6,284,781 B1),
Senior Party.

Patent Interference No. 105,298

TITLE OF PAPER

ADDENDUM 2

FILE COPY REQUEST
Patent Interference No. 105,298

Attach a copy of section E of this DECLARATION to this REQUEST. On the copy, circle each patent and application that you are requesting. Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address,³ including street, city, state, zip code, and telephone number:

3. Telephone, including area code: _____

³ Provide a street address, NOT a Post Office Box. The Office of Public Records uses a commercial overnight delivery service rather than the United States Postal Service to deliver file copies.